

## **REMARKS**

Applicants herein make a REQUEST FOR CONTINUED EXAMINATION (RCE) under 37 C.F.R. §1.114.

### **Heading I**

Claims 33 – 40 and 42 – 60 stand rejected under 35 U.S.C. 103(a) being unpatentable over Smith in view of Desai, the following background applies for all subheadings herein.

Under the M.P.E.P standards, any alleged motivation to combine or modify must be objectively verifiable. The M.P.E.P recognizes the pitfalls associated with the tendency to subconsciously use impermissible “hindsight” when an examiner attempts to establish such a rationale. The M.P.E.P has set forth at least two rules to ensure against the likelihood of such impermissible use of hindsight. The first rule is that “under 35 U.S.C. § 103, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention ‘as a whole’ would have been obvious at that time to that person. M.P.E.P. § 2142.

Applicants respectfully point out that nowhere has the Office Action pointed to any objectively verifiable motivation to modify and/or combine the teachings of the art of record to produce the claimed invention beyond the following bare assertions.

### **Subheading I - A: Independent Claim 33**

Smith teaches dynamic assignment of surveys, hence the title of Smith: “Dynamically Assigning A Survey to a Respondent.” Smith emphasis on dynamic assignment is contrary to the present application’s use of lists of designated e-mail recipients chosen to receive e-mails having network links to surveys. The present application takes a predictive approach by determining beforehand who receives by e-

mail what surveys and by recording the names of the recipients in various e-mail lists associated with particular surveys to be received. Smith terms this approach of using e-mail to distribute surveys to predetermined recipients of the present application as a static assignment approach and teaches that the approach of static assignment is undesirable.

The static assignment approach of the present application does not necessarily imply that the assignments of surveys to survey takers need never be changed, however, unlike Smith, the assignments of the present application are not generated or changed on the fly depending upon input by an end user or potential survey candidate. Rather, the assignments of the present application are originated or changed by an administrator of an e-mail recipient list before going ahead with transmission of e-mail to designated recipients on the list. Smith uses a dynamic assignment approach and teaches that the static assignment approach such as found in the present application can have problems. For instance, according to Smith, assignment of surveys following the static assignment approach, such as found with the present application, can end up being less effective than they could otherwise be as pointed out in paragraphs [143] and [144] of Smith.

Given the dynamic assignment approach of Smith, it is not surprising that paragraphs [0108] – [0110] of Smith only mention use of e-mail in the context of sending results of surveys – that is after the surveys have been conducted. On the other hand, the Office Action incorrectly states that paragraphs [0108] – [0110] of Smith teach management of a list of e-mail recipients chosen to receive an e-mail linking to a survey. In addition, the Applicants could not find anywhere in Smith and/or Desai alone or in combination a teaching concerning claim 33 regarding an e-mail list management facility configured to provide management capability through the network browser of the survey design machine of a list of e-mail recipients chosen to receive an e-mail associate with a survey, the list being stored on the host machine. Yet, the Office Action puts forth a bare assertion that Smith teaches such.

The Office Action incorrectly states that Desai (paragraphs [0005], [0035], and [0048]) teaches use of e-mail containing a network link to provide access to a survey and appears to be a bare assertion to reject claim 33. The Office Action's statement is incorrect because first, paragraph [0005] of Desai teaches a conventional transmission of surveys as attachments within e-mails – no links within e-mail are mentioned. Paragraphs [0034] and [0035] of Desai teach use of e-mail or a Web server to forward questionnaires as self-configurable applets – no links in e-mail are mentioned. Paragraph [0048] of Desai teaches generation of questionnaire response applets – no links in e-mail are mentioned.

The Office Action's suggestion to combine Smith in view of Desai is not found either explicitly and/or implicitly in Smith and/or Desai. Furthermore, there is no sworn affidavit by the Examiner found in the Office Action attesting to the veracity of the Examiner's personal expert knowledge of the level of understanding regarding the subject matter of one of ordinary skill in the art at the time of invention associated with issues of obviousness in forming the combination of Smith in view of Desai. Consequently, the suggestion offered by the Office Action to combine Smith in view of Desai is purely a bare assertion since the explanation offered by the Office Action as to the reasonableness of the suggestion to combine is given without any attestation by signed affidavit as to the fact that the suggestion and explanation came from a properly qualified expert.

Given the use of bare assertion for supporting argumentation in the rejection of claim 33, the Office Action has failed to support a prima facie case of obviousness for claim 33. Consequently, it is believed that claim 33 stands in condition for allowance.

#### Subheading I - B. Independent Claim 47

Claim 47 was rejected, according to the Office Action, "on grounds corresponding to the arguments given above for rejected claim 33." Since the arguments by the Office Action in rejecting claim 33 used bare assertion involving inaccurate representation of the content of Smith and Desai and an unqualified opinion regarding a proposed suggestion to combine Smith and Desai as discussed above, the

arguments of the Office Action regarding claim 33 have similarly failed to support a prima facie case of obviousness to reject claim 47.

In rejecting claim 47, the Office Action further inaccurately represents paragraphs [0033] – [0035] of Desai by stating that these paragraphs teach a portion of claim 47 regarding using a survey design computer via the network to edit a list of e-mail recipients stored on the host computer wherein some of the recipients are to be sent an e-mail containing a network link to access a survey. Contrary to this inaccurate statement by the Office Action, paragraphs [0033] – [0035] only teach forwarding a questionnaire to a client. Furthermore, the Applicant could not find anywhere in Desai the teaching of the portion of claim 33 as stated to exist by the Office Action. Consequently, the Office Action's use of Desai in an attempt to supply teaching for the portion of claim 33 is merely a bare assertion that such a teaching exists in Desai.

As discussed above regarding the claim 33 rejection, Smith teaches away from a static assignment approach of using e-mail to send surveys or links to surveys to recipients identified on a list. This is because Smith takes a dynamic assignment approach, which does not rely on lists of e-mail recipients to receive surveys. Although the Office Action mentions that an invitations to participate could be viewed as surveys, the Applicant could find no descriptions in Smith of use lists of e-mail recipients for which Desai could hypothetically provide editing capability. The Office Action has simply put forth a bare assertion when proposing a combination of Smith in view of Desai regarding using a survey design computer via the network to edit a list of e-mail recipients stored on the host computer wherein some of the recipients are to be sent an e-mail containing a network link to access a survey.

The Office Action's suggestion to combine Smith in view of Desai is not found either explicitly and/or implicitly in Smith and/or Desai regarding the combination proposed by the Office Action of Smith in view of Desai to reject claim 47. Furthermore, there is no sworn affidavit by the Examiner found in the Office Action attesting to the veracity of the Examiner's personal expert knowledge of the level of understanding regarding the subject matter of one of ordinary skill in the art at the time of invention

associated with issues of obviousness in forming the combination of Smith in view of Desai. Consequently, the suggestion offered by the Office Action to combine Smith in view of Desai with regard to the claim 47 rejection is purely a bare assertion since the explanation offered by the Office Action as to the reasonableness of the suggestion to combine is given without any attestation by signed affidavit as to the fact that the suggestion and explanation came from a properly qualified expert.

Given the use of bare assertion for supporting argumentation in the rejection of claim 47, the Office Action has failed to support a prima facie case of obviousness for claim 47. Consequently, it is believed that claim 47 stands in condition for allowance.

#### Subheading I - C. Independent Claims 52, 53, and 54.

Claims 52, 53, and 54 were rejected, according to the Office Action, "on grounds corresponding to the arguments given above for rejected claims 33 and 47 and are similarly rejected." Since the arguments by the Office Action in rejecting claim 33 and claim 47 used bare assertion involving inaccurate representation of the content of Smith and Desai and an unqualified opinion regarding a proposed suggestion to combine Smith and Desai as discussed above, the arguments of the Office Action regarding claim 33 and claim 47 have similarly failed to support a prima facie case of obviousness to reject claims 52, 53, and 54.

#### Subheading I - D. Independent Claim 55.

Claim 55 was rejected, according to the Office Action, "on grounds corresponding to the arguments given above for rejected claims 33 and 47 and [is] similarly rejected." Since the arguments by the Office Action in rejecting claim 33 and claim 47 used bare assertion involving inaccurate representation of the content of Smith and Desai and an unqualified opinion regarding a proposed suggestion to combine Smith and Desai as discussed above, the arguments of the Office Action regarding claim 33 and claim 47 have similarly failed to support a prima facie case of obviousness to reject claim 55.

Furthermore, claim 55 includes the survey creation engine being configured to provide to the network browser of the survey design machine at least one function to resize web content objects to be added during survey creation. The Applicants could not find anywhere in Smith and/or Desai where this was suggested or taught, so claim 55 is believed to be allowable for this additional reason.

#### Subheading I - E. Independent Claim 57.

Claim 57 was rejected, according to the Office Action, "on grounds corresponding to the arguments given above for rejected claims 33 and 47 and [is] similarly rejected." Since the arguments by the Office Action in rejecting claim 33 and claim 47 used bare assertion involving inaccurate representation of the content of Smith and Desai and an unqualified opinion regarding a proposed suggestion to combine Smith and Desai as discussed above, the arguments of the Office Action regarding claim 33 and claim 47 have similarly failed to support a prima facie case of obviousness to reject claim 57.

Furthermore, claim 57 includes the survey creation engine being configured to provide to the network browser of the survey design machine at least one function to select progress bars to be added by the survey creation engine. The Applicants could not find anywhere in Smith and/or Desai where this was suggested or taught, so claim 57 is believed to be allowable for this additional reason.

#### Subheading I - F. Independent Claim 58.

Claim 58 was rejected, according to the Office Action, "on grounds corresponding to the arguments given above for rejected claims 33 and 47 and [is] similarly rejected." Since the arguments by the Office Action in rejecting claim 33 and claim 47 used bare assertion involving inaccurate representation of the content of Smith and Desai and an unqualified opinion regarding a proposed suggestion to combine Smith and Desai as discussed above, the arguments of the Office Action regarding claim 33 and claim 47 have similarly failed to support a prima facie case of obviousness to reject claim 58.

Furthermore, claim 58 includes the survey creation engine being configured to provide to the network browser of the survey design machine at least one function to perform survey background design. The Applicants could not find anywhere in Smith and/or Desai where this was suggested or taught, so claim 58 is believed to be allowable for this additional reason.

#### Subheading I - G. Independent Claim 59.

Claim 59 was rejected, according to the Office Action, "on grounds corresponding to the arguments given above for rejected claims 33 and 47 and [is] similarly rejected." Since the arguments by the Office Action in rejecting claim 33 and claim 47 used bare assertion involving inaccurate representation of the content of Smith and Desai and an unqualified opinion regarding a proposed suggestion to combine Smith and Desai as discussed above, the arguments of the Office Action regarding claim 33 and claim 47 have similarly failed to support a prima facie case of obviousness to reject claim 59.

Furthermore, claim 59 includes the survey creation engine being configured to provide to the network browser of the survey design machine at least one function to select font of text used of a survey created by the survey creation engine. The Applicants could not find anywhere in Smith and/or Desai where this was suggested or taught, so claim 59 is believed to be allowable for this additional reason.

#### Subheading I - H. Independent Claim 60.

Claim 60 was rejected, according to the Office Action, "on grounds corresponding to the arguments given above for rejected claims 33 and 47 and [is] similarly rejected." Since the arguments by the Office Action in rejecting claim 33 and claim 47 used bare assertion involving inaccurate representation of the content of Smith and Desai and an unqualified opinion regarding a proposed suggestion to combine Smith and Desai as discussed above, the arguments of the Office Action regarding claim 33 and claim 47 have similarly failed to support a prima facie case of obviousness to reject claim 60.

Furthermore, claim 60 includes the survey creation engine being configured to provide to the network browser of the survey design machine at least one function to select color scheme of a survey created by the survey creation engine. The Applicants could not find anywhere in Smith and/or Desai where this was suggested or taught, so claim 60 is believed to be allowable for this additional reason.

#### Conclusion of Heading I

As discussed above, the art of record, namely, the combination of Smith in view of Desai, does not contain sufficient teaching to render obvious to one of ordinary skill in the art at the time of the invention the pending independent claims, namely, claims 33, 47, 52 – 55, and 57 - 60 and consequently, the dependent claims 34 – 46, 48 – 51, and 56.

Consequently, it is believed that the Applicants' patent application has been used as a template to piece references together in an attempt to reject the pending claims and that this attempt fails because these references do not lend themselves to be combined or modified with each other to read on the claimed invention. In addition these references have been misread, such as Smith allegedly containing an e-mail list management facility configured to provide management capability through the network browser of the survey design machine of a list of e-mail recipients chosen to receive an e-mail associate with a survey, the list being stored on the host machine, to force them to read on the claimed invention.

Accordingly, insofar as that the only objectively verifiable teachings of record showing the alleged motivation to modify and/or combine reside in Applicants' patent application, it follows that the Office Action has used Applicants' patent application as a template by which to piece together the related art to reach Applicants' claims at issue. As set forth above, under the M.P.E.P. standards this is impermissible hindsight. Accordingly, Applicants respectfully request that Examiner allow the pending claims for at least this reason.



As discussed above, all the pending independent claims (claims 33, 47, 52 – 55, and 57 – 60) are believed to be allowable. The pending dependent claims (claims 34 – 46, 48 – 51, and 56) are also believed to be allowable, based at least in part upon their dependencies.

### ***Request for Continued Examination***

Applicants herein make a REQUEST FOR CONTINUED EXAMINATION (RCE) under 37 C.F.R. §1.114. Applicants' current Response and Amendment, including the. Applicants have additionally enclosed the requisite fee under §1.17(e).

### **CONCLUSION**

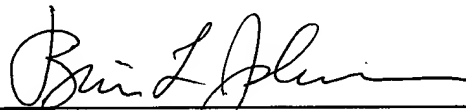
In view of the foregoing amendments and remarks, applicants respectfully request a Notice of Allowance relating to all pending claims, all having been previously allowed.

The Examiner is encouraged to phone applicants' attorney, Brian L. Johnson, to resolve any outstanding issues and expedite issuance of a final Notice of Allowance.

Entry of the Amendment is respectfully requested.

Respectfully submitted,

Davis Wright Tremaine LLP



Brian L. Johnson  
Attorney for Applicants  
Registration No. 40,033

Davis Wright Tremaine LLP  
2600 Century Square  
1501 Fourth Avenue  
Seattle, Washington 98101-1688  
Telephone: 206-628-7621  
Facsimile: 206-628-7699